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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,010	10/06/2000	William W. Smith III	PSTM0002/MRK	9819

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EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,010

Applicant(s)

SMITH ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/6/00 & 4/26/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2004/04/26</u> | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and

C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.

2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 119(e) is acknowledged.

3. The proposed drawing correction filed April 26, 2004 has been approved.

4. The declaration/affidavit filed 26 April 2004 has been considered by the examiner.

5. The disclosure is objected to because of the following informalities:

A) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) how the program proceeds after box(es):

(a) 3026 of fig. 36c if the inquiry is "NO" as this figure is described in the paragraph number 298 on pages 57-58 of the substitute specification filed April 26, 2004, "As depicted in Figures 36C through 36D, ... to different parties for various billing options).";

(b) 1163, 1168, 1169, 1172 & 1175 of fig. 39b if the inquiry is "NO" as this figure is described in the paragraphs numbers 318-326 on pages 62-64 of the substitute specification filed April 26, 2004, "Continuing with FIGS. 39A through 39C, next ... Carrier/Service in the delivery rate set 1157."; and

(c) 1180, 1184, 1187 & 1190 of fig. 36c if the inquiry is "NO" as this figure is described in the paragraphs numbered 326-333 on pages 64-65 of the substitute specification filed April 26, 2004, "Next 1179, the System determines ... in the delivery rate set 1157.".

In this regard, it is noted that merely mentioning either a feature or a number with out mentioning the device or operation or number or feature relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

B) the following errors have been noted in the specification:

(1) in regard to the objections to the specification noted above:

(a) in paragraph number 298 at line 7 change "3) Determine the zone," to -3) If the weight and dimensions do not violate the carrier's business rules, step 3026, determine the zone--.

(b) in paragraph number 318 at line 1 change "next," to --if either the shipping timespan did not end on a Saturday, step 1163, or after step 1165,--.

(c) in paragraph number 320 at line 1 change "The System," to -- If either the shipping timespan did not end on a Sunday, step 1168, or after step 1167, the System--.

(d) in paragraph number 322 at line 1 change "the System next" to --if either the there is not business day delivery, step 1169, or after step 1171,--.

(e) in paragraph number 324 at line 1 change "the System then," to --if either e-mail delivery notification has not been selected, step 1172, or after step 1174, the System then--.

(f) in paragraph number 326 at line 1 change "Next 1179, the System determines," to -Next 1179, if either verbal delivery notification has not been selected, step 1175, or after step 1178, the System determines--.

(g) in paragraph number 328 at line 1 change "the System then," to --if either guaranteed delivery time has not been selected, step 1180, or after step 1182, the System then--.

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(g) in paragraph number 330 at line 1 change "the System next," to --if either the shipping location is not "Call for Pickup", step 1184, or after step 1186, the System next--.

(g) in paragraph number 332 at line 1 change "The System then," to --If either residential delivery service has not been selected, step 1187, or after step 1189, the System then--.

(g) in paragraph number 333 at lines 4-5 change "1193 before proceeding," to --1193. Next, if either loss protection has not been selected, step 1190, or after step 1193, the System proceeds--.

Appropriate correction is required.

6. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

7. Claims 1-30 are provisionally rejected under the judicially created doctrine of double patenting over either:

- A) claims 1-72 of copending Application No. 09/680,649; or
- B) claims 1-89 of copending Application No. 09/680,654; or
- C) claims 1-6 of copending Application No. 09/684,014; or
- D) claims 1-9 of copending Application No. 09/684,861; or
- E) claims 1-21 of copending Application No. 09/684,865; or
- F) claims 1-53 of copending Application No. 09/684,866; or
- G) claims 1-63 of copending Application No. 09/684,869; or
- H) claims 1-57 of copending Application No. 09/685,077; or
- I) claims 1-58 of copending Application No. 09/685,078.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

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7.1 The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

A) in a computer network system comprising a central computer/server connected to a number of user/client computers and configured/programmed to provide various interactive shipping services, such as rating, rate comparison and tracking for multiple carriers to the users in response to the requests of users sent to the server from the client computers via the network.

It is noted that the information, whether it is shipping rate data, rate comparison data, tracking data, etc. or how the requested information is displayed to the user does not affect the operation of the basic system as recited in each of the identified application, hence the type of information/data is considered to be non-functional descriptive material. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

7.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985);

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In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

7.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

7.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8.1 Claims 1-30 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by PRNewswire release from Tulsa Oklahoma (herein after TanData™) or Thiel (5,699,258).

8.1.1 In regard to claim 20, since this claim repeats subject matter recited in other claims, when those claims are mentioned, then claim 20 has been addressed.

8.1.2 In regard to claims 1-30, TanData™ discloses an internet based shipping system that comprises properly programmed server and client systems to accept rating related information from users and then return to the user from the server the shipping rate for a number of different carriers. Further, the TanData™ system permits the user track the item being shipped. It is noted that the Internet is a global communications network.

8.1.3 In regard to claims 1-30, Thiel ('258) discloses a networked based shipping system that comprises properly programmed central computer/server and client shipping systems to accept rating related information from users and then return to the user from the server the shipping rate for a number of different carriers. Further, the Thiel ('258) system permits the user track

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the item being shipped. It is noted that radio waves are used to transmit information around the world and hence the communications network of Thiel ('258) would be considered as a global communications network.

8.1.4 Further, since:

A) the internet is a communications network as is the wireless network of Thiel ('258);

B) the claims fail to recite sufficient structure so as to distinguish a particular type of communications network;

C) the claims fail to recite sufficient acts or functions so as to distinguish the particular operation of the instant invention over the applied prior art,

one of ordinary skill at the time the invention would recognize the two separate types of networks as functionally equivalent. Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

9. Response to applicant's arguments.

9.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

9.2 As per the obvious double patenting rejection:

A) the terminal disclaimer filed on April 26, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the

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expiration date of either application nos. A) claims 1-72 of copending Application No. 09/680,649; or 09/680,654; or 09/684,014; or 09/684,861; or 09/684,865; or 09/684,866; or 09/684,869; or 09/685,077; or 09/685,078, has been reviewed and is NOT accepted.

B) The assignee has not established its ownership interest in the application, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee, or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office (37 CFR 3.73(b)).

Hence, applicant's arguments are non persuasive.

9.3 As per the 35 U.S.C. § 102 rejection, since:

A) the use of the patents to Nichols to explain the differences in the operations of the claimed invention and the applied prior art are directed to unclaimed distinctions and merits since, applicant has chosen language that broadly recites the functions of the claimed invention and not the actual acts carried out by the disclosed invention, see "Seal-Flex, Inc. v. Athletic Track and Court Construction, 172 F.3d 836, 850, 50 USPQ2d 1225, 1234 (Fed. Cir. 1999) (Radar, J., concurring) ("claim elements without express step-plus-function language may nevertheless fall within 112 6th if they merely claim the underlying function without recitation of acts for performing that function...In general terms, the underlying function' of a method claim element corresponds to what that element ultimately accomplishes in relationship to what the other elements of the claim and the claim as a whole accomplish. Acts,' on the other hand, correspond to how the function is accomplished...", hence it would be reasonable to interpret any and all machines/processes that would perform the functions recited in the claims as being within the scope of the claimed invention.

B) as stated above one of ordinary skill would readily recognize that the applied prior art accomplishes the functions recited in the claims under consideration.

Hence, applicant's arguments are non persuasive.

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10. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

11.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

11.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

11.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

06/21/04



Edward R. Cosimano
Primary Examiner A.U. 3629